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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/924,298

08/08/2001

Vincent Bryan

46739/262600

3319

27683 7590 04/13/2007  
HAYNES AND BOONE, LLP  
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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/924,298

**Applicant(s)**

BRYAN ET AL.

**Examiner**

Pedro Philogene

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 93-96, 101-103, 106-110, 112, 113, 121 and 122 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 114-119 is/are allowed.
- 6) ☒ Claim(s) 1-44, 56-61, 66, 67, 70, 71, 74-76, 81, 82, 84-87, 90-92 and 120 is/are rejected.
- 7) ☒ Claim(s) 88, 89 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-44,56-61,66,67,70,71,74-76,81,82,84-96,101-103,106-110 and 112-122.

***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 1/26/07 is acknowledged. The traversal is on the ground(s) that certain of the claims in Group I should be listed in Group II, because the claims recite, "a central body positioned and articulate between two shells". This is not found persuasive because the combination as claimed does not require the particulars of the subcombination as claimed because the deformable resilient central body does not require the particulars of the combination claimed. The subcombination has separate utility such as a cushion. The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 13-15,21,24-29,37,56-61,66,67,70-71, are rejected under 35 U.S.C. 102(b) as being anticipated by Buttner-Janz et al. (5,401,269)

With respect to the above claims Buttner-Janz et al disclose a central body (3) and articulable between two shells (1,2), the central body having a resilient, deformable portion and a coating material encasing the central body wherein the resilient deformable portion allows motion in the joint implant and the coating material has a different hardness from the resilient, deformable portion; a motion limiting device; as best seen in FIGS.8-15; a post (13) in the shells in the inner surface of the shells; as set

forth in column 2, line 63-68, column 3, lines 1-167, column 4, lines 1-37, and as best seen in FIGS.1-11.

Claims 74-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuhrmann et al. (5,002,576).

With respect to the above claims, Fuhrmann et al disclose a bone joint implant comprising a central body (2) and sleeve (1) positioned between two opposing shells (3,4) has an upper and lower contact surface, and at least one sealable opening (21) in at least one of the shells, for the introduction of the lubricant into the implant after the implant has been assembled; as set forth in column 2, lines 50-68, column 3, lines 1-68, column 4, lines1-12; and as best seen in FIGS.1-4.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 10-12,18-20,22,23,30-36,81-82,84-85,120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttner-Janz et al. (5,401,269) in view of Bryan et al. (5,674,296).

With respect to the above claims, it is noted that Buttner-Janz et al disclose all the limitations, except for a flexible sheath defining an enclosed cavity and a circumferential groove adapted to receive a retaining ring and tab extending in the

shells; as claimed by applicant. However, in a similar art, Bryan et al evidences the use of an implant having a flexible sheath a circumferential groove, a ring, a tab and a concaval-convex shells to provide a watertight seal to prevent the migration of fluids between the implant and adjacent parts of the anatomy.

Therefore, given the teaching Bryan et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Butter-Janz et al., as taught by Bryan et al., to provide a watertight seal to prevent the migration of fluids between the implant and adjacent parts of the anatomy.

Claims 3, 16, 17, 38-40, 41-44, 86-87,90-92, are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttner-Janz et al. (5,401,269) in view of Bryan et al. (5,674,296) in view of Fuhrmann et al. (5,002,576).

With respect to the above claims, it is noted that the above combination of references teaches all the limitations; except for openings in the shell for injecting a liquid lubricant into the cavity; as claimed by applicant. However, in a similar art, Fuhrmann et al., evidence the use of openings in the shells to serve to fill or ventilate the interior of the implant.

Therefore, given the teaching of Fuhrmann et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Buttner-Janz/Bryan et al, as taught by Fuhrmann et al., to serve to fill or ventilate the interior of the implant.

***Allowable Subject Matter***

Claims 88-89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 114-119 are allowed.

### ***Response to Amendment***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,556,431	Buttner-Janz et al	9-1996
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
April 4, 2007

  
PEDRO PHILOGENE  
PRIMARY EXAMINER